

REMARKS/ARGUMENTS

Claims 35-76 are pending. By this Amendment, claims 35, 36, 38, 39, 42, 45, 48, 50, and 58 are amended, and new claims 66-76 are added.

The Office Action in paragraph 1 refers to incorporation of essential material in the specification by reference to an unpublished US application, foreign application or patent, or to a publication as being improper. However, Applicant is unaware of any incorporation by reference in the present application of any essential material.

The Office Action objects to the claims because of informalities. It is submitted that the claims as amended obviate the informalities. Withdrawal of the objections is requested.

The Office Action rejects claims 35-41 and 49-57 under 35 USC 112, second paragraph. It is submitted that claim 35 as amended obviates the rejection. Withdrawal of the rejection is requested.

The Office Action rejects claims 35-49 under 35 USC 102(e) over Garrett (US Pat. 6,926,241). This rejection is respectfully traversed.

Garrett discloses accessories for use in pitched roof construction. As illustrated in Figs. 12-26 for example, Garrett discloses a material and supply support having a main support table 1, which may have a lip on the outboard side of the apparatus. Main support bars 2 may be provided in a slidable fashion on connecting rods 4 and 5. See col. 22, lines 19-35. The main support table 1 is provided with angle adjustment to compensate for different roof pitches. Fig. 21 illustrates the material and supply support holding a water jug and Fig. 22 illustrates it holding a cooler. See col. 24, lines 7-12.

However, independent claim 35 of the application recites “a covering arrangement suitable for covering a water tank which can be mounted onto an external portion of a building, said covering arrangement being made in the shape of an architectural component of the building.” Likewise, independent claim 42 recites “a covering arrangement suitable for covering a component of an air-conditioning system which can be mounted onto an external portion of a building, said covering arrangement being made in the shape of an architectural component of the building.”

For claim 35, the Office Action refers to paragraph 28 as supposedly showing the covering arrangement, and paragraph 83 as showing the water tank. For claim 42, the Office Action refers to “tarp” in paragraph 83 as the covering arrangement.

Paragraph 28 refers to “pump jack poles” and a “scaffold-type walkboard”. The “pump jack poles” and a “scaffold-type walkboard” of paragraph 28 of Garrett are not a covering arrangement suitable for covering a water tank which can be mounted onto an external portion of a building, as recited in claim 35. Garrett does not disclose the pump jack poles and scaffold-type walkboard could be used to cover a water tank (such as the water jug illustrated in Fig. 21). Paragraph 83 also does not mention a tarp. The only mention of a tarp in Garrett is at paragraph 308 where Garrett refers to a custom tarp used to cover materials, stating:

“[0308] The addition of fourteen inch safety rails prevents materials such as tile and slate from falling off the roof. The platform easily adjusts to roof truss layouts of two feet, 18-inch and 16 inch on center, as well as other dimensions. The ROOFSTOCKER.TM. increases safety for employees and customers and decreases liability to the contractor. A custom tarp may be made to cover materials on the ROOFSTOCKER.TM. Standard size in the preferred embodiment is 54" in length and 42" in width.”

Garrett does not disclose or suggest a covering arrangement suitable for covering a water tank (or a component of an air-conditioning system, claim 42) and being made in the shape of an architectural component of the building, as recited in claims 35 and 42. The pump jack poles and scaffold-type walkboard are not a covering arrangement for covering a water tank (or a component of an air-conditioning system) and are not architectural components of the building, but instead are items that are temporarily used by construction workers, such as roofers, and then removed from the building after construction. Likewise, the tarp disclosed in par. 308 is not a covering arrangement being made in the shape of an architectural component of the building, as recited in claims 35 and 42. Instead, it is a tarp used to temporarily cover materials. The tarp is not made in the shape of an architectural component of the building, but is instead merely a flat tarp.

As disclosed in the specification (and recited in dependent claims), architectural components of the building may include, e.g., a chimney cap, a skylight, an attic skylight, verandas or balconies. See page 10, lines 20-27, for example. The architectural components are selected to hide the water tank or component of an air-conditioning system from view, and to harmonize the covering arrangement with the building and with the architectural style of the building itself.

For the above reasons, Garrett does not anticipate independent claims 35 or 42, or dependent claims 36-41 and 43-49. Withdrawal of the rejection is requested.

The Office Action rejects claims 50-57 under 35 USC 103 over Garrett. This rejection is respectfully traversed.

The Office Action asserts that it would have been an obvious matter of design choice to form the architectural component as any type of decorative design, as such a change would have

involved a mere change in shape of a component. The Office Action cites *In re Dailey*, 149 USPQ 47 (CCPA 1996) for the assertion that a change in shape is generally recognized as being within the level of ordinary skill in the art.

However, in *In re Dailey*, both the claimed invention and the prior art applied by the Examiner concerned a nursing container for infants, where the claimed invention (claims 27 and 28) differed from the prior art in the recitation of a “less than a hemisphere” configuration. The Court found that no convincing argument was presented that “the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container.” *Id* at 49-50.

Claim 50 of the present application recites “Apparatus according to claim 35, wherein said architectural component has a shape selected from a group comprising: a chimney cap, a skylight, an attic skylight, a veranda, a balcony, a column, and an arch.” Garrett merely discloses a tarp for covering roofing items used by construction workers. In contrast to *In re Dailey*, the claimed invention of a covering arrangement in the shape of an architectural component of a building does not concern a same type of structure as the prior art. In particular, the claimed covering arrangement in the shape of an architectural component of a building is distinct from a flat tarp. Further, the claimed covering arrangement in the shape of an architectural component of a building provides significant advantages over a tarp, in that it hides the water tank or component of an air-conditioning system from view, and/or it harmonizes the covering arrangement with the building and/or with the architectural style of the building itself.

Moreover, the Board of Patent Appeals and Interferences has held that a claimed shape (chips) is important because it results in a product which is distinct from the reference product

(french fries). *Ex parte Hilton*, 148 USPQ 356 (Bd. App. 1965). The claimed covering arrangement in the shape of an architectural component of a building results in a product distinct from a tarp, and the claimed architectural component having a shape selected from a group comprising: a chimney cap, a skylight, an attic skylight, a veranda, a balcony, a column, and an arch, as recited in claim 60, is also distinct from a tarp.

The wall arrangement, window, grille, building bricks, and panel elements of claims 51-55 are also asserted by the Office Action to be a matter of design choice. The claimed wall arrangement, window, grille, building bricks, and panel elements of claims 51-55 also result in a product distinct from a tarp as disclosed in Garrett. The Office Action points to no teaching as to why it would be obvious to modify a tarp to result in any of these claimed elements.

For the above reasons, and because of there dependence from claim 55, Garrett does not render obvious claims 50-57. Withdrawal of the rejection is requested.

The Office Action rejects claims 58-65 and 68 under 35 USC 103 over Drew (US Pat. 3,742,659) in view of Cherkas (US Pat. 5,858,494). This rejection is respectfully traversed.

The Office Action asserts that Drew discloses a building with a functional, non-architectural element with a cover, but admits that Drew does not disclose any of the claimed steps recited in claim 58. The Office Action asserts that it is notoriously well know that items can be decorated, that such decoration can comprise reproducing a selected part of an original to get an image therefrom onto a layer element, and then applying the layer element onto a support surface element. The Office Action cites Cherkas as disclosing decorating a lure by reproducing a selected part of an original (fish) to get an image on a layer element and then applying the layer element onto a support surface (lure). The Office Action asserts that it would have been obvious

to modify Drew to use the method of creating decoration of Cherkas in order to better disguise and blend in the architectural element.

Cherkas is non-analogous art. The customizing of a fishing lure of Cherkas is not the same field of endeavor as the claimed invention (mounting of a functional, non-architectural element onto a building), and Cherkas does not deal with the same problems that were confronted by the inventor, harmonizing the functional, non-architectural element mounted on a building with an external portion of the building. Further, even if Cherkas qualifies as analogous art, which it does not, the Office Action provides no motivation as to why one of ordinary skill in the art of mounting equipment on a roof as in Drew would look to the art of fishing lures of Cherkas. As such, one of ordinary skill in the art would not look to decals for fishing lures when consider equipment mounted on a roof as in Drew.

For the above reasons, it is submitted that the rejection of the claims as obvious over Drew in view of Cherkas is improper. Withdrawal of the rejection is requested.

The Office Action rejects claims 66-67 under 35 USC 103 over Drew in view of Cherkas and further in view of Garrett. This rejection is respectfully traversed.

Claims 66-67 would not have been obvious over the applied references due to claims 66-67 dependence from claim 58, and because Garrett does not solve the deficiencies of Drew and Cherkas noted above regarding claim 58. Withdrawal of the rejection is requested.

New claims 68-76 have been added to highlight this and/or other features. Further, it is noted that claim 76 is written in means-plus-function format, and therefore the “covering means for covering a functional, non-architectural component mounted onto an external portion of a building in such a way that the component is substantially hidden from view,” “means for architecturally and aesthetically harmonizing the covering means with the external portion of the

building and/or the architectural style of the building” and “means for adjustably maintaining said functional, non-architectural component in a substantially vertical position” recited in claim 76 should be interpreted in light of the structure disclosed in the specification that performs the recited function, per 35 USC 112, sixth paragraph. Any prior art applied against claim 76 should perform the recited function, and be the same or equivalent structure. It is submitted that none of the prior art applied in this application, such as Garrett’s tarp, anticipates or renders obvious claim 76.

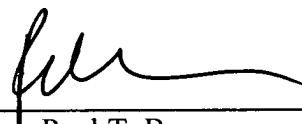
Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the below listed telephone number.

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140 under Order No. PTB-5516-2.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____


Paul T. Bowen
Reg. No. 38,009

PTB: DJZ
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100